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movement of a secondary game piece is limited when the secondary game piece is separated from a primary game piece by a predetermined number of spaces.

20. (Original) The game of Claim 19, wherein the predetermined number is five spaces.

21. (New) The method of Claim 12, wherein placing the selected game unit on the playing surface involves placing at least one primary game piece and at least one secondary game piece of the selected game unit on the same space of the playing surface.

22. (New) The method of Claim 12, wherein placing the selected game unit on the playing surface involves placing the at least one primary game piece and the at least one secondary game piece of the selected game unit on different spaces of the playing surface.

REMARKS

With this amendment, Claims 1, 3-8, and 10-22 are pending in the present application. Applicant has currently amended Claims 1, 3, 10, 12, 15 and 16 and added Claims 21 and 22. In view of these amendments and the following remarks, Applicant respectfully submits that all of the claims of the above-identified application are in condition for immediate allowance.

Specification

Examiner objects to Claims 1-11 on the basis that those claims recite a method of making but do not provide method steps for how the game is to be made; specifically, Examiner asserts that the preambles of Claims 1-11 are not supported by limitations breathing life into a method of making the game. Without addressing the merits of Examiner's assertion, Applicant has amended, without prejudice, Claims 1, 3-8, 10 and 11 from a method of making to a method of playing the game, and canceled, without prejudice, Claims 2 and 9. Applicant reserves the right to pursue original Claims 1-11 in a subsequent application. Based on the amendment to Claims 1-11, Applicant respectfully requests Examiner to withdraw this objection.

Claim Rejections – 35 U.S.C. § 112 - *Claims 1-11*

Examiner rejected Claims 1-11 under 35 U.S.C. § 112 as being indefinite. As previously presented, Claims 1-11 provide for a method of making a game. Examiner asserts that Claims 1-11 merely recites a use without any active, positive steps delimiting how this use is actually practiced. Without addressing the merits of Examiner's rejection, Applicant has amended, without prejudice, Claims 1, 3-8, 10 and 11 from a method of making to a method of playing the

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game, and canceled, without prejudice, Claims 2 and 9. Applicant reserves the right to pursue original Claims 1-11 in a subsequent application. Based on the amendment to Claims 1-11, Applicant respectfully requests Examiner to withdraw this rejection.

Claim Rejections – 35 U.S.C. § 101

Examiner rejected Claims 1-11 under 35 U.S.C. § 101. Examiner asserts that Claims 1-11 recite a use, without setting forth any steps involved in the process, which results in an improper definition of a process. Without addressing the merits of Examiner's rejection, Applicant has amended, without prejudice, Claims 1, 3-8, 10 and 11 from a method of making to a method of playing the game, and canceled, without prejudice, Claims 2 and 9. Applicant reserves the right to pursue original Claims 1-11 in a subsequent application. Based on the amendment to Claims 1-11, Applicant respectfully requests Examiner to withdraw this rejection.

Claim Rejections – 35 U.S.C. § 112 - *Claims 12-15*

Examiner rejected Claims 12-15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12-15 are directed to a method of playing. Examiner suggests that Claims 12-15 lack proper structure and asserts that in absence of proper structure of an apparatus, it is not possible to practice a method. Examiner also asserts that Claim 12 is confusing due to limitations being in run-on sentence format and that "awarding" a penalty as recited in Claim 15 for keeping pieces separated by a predetermined number is contrary to keeping the pieces separated within a predetermined number of spaces as recited in Claim 12. Examiner further asserts that it is not clear as to whether pieces move combined or separately or a roll total divided between both.

Applicant has amended Claim 12 to recite an apparatus "comprising at least one game unit, wherein the at least one game unit has at least one primary game piece and at least one secondary game piece, and a playing surface having a plurality of spaces for placement of the at least one primary game piece and the at least one secondary game piece, the plurality of spaces forming a path." Applicant submits that this amendment adds proper structure to the game allowing one to practice the method. Applicant has also amended Claim 12 to separate the limitations of the method so that limitations are indented for clearer meaning. Accordingly, Applicant respectfully requests Examiner to withdraw the rejection with respect to Claims 12-14.

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With respect to Claim 15, Applicant has amended the claim to recite “imposing a penalty when a secondary game piece is separated from the at least one primary game piece by **more than the** predetermined number of spaces.” Based on this amendment, Applicant submits that Claim 15 is not contrary to “keeping the pieces separated within a predetermined number of spaces” as recited in Claim 12. Accordingly, Applicant respectfully requests Examiner to withdraw this rejection with respect to Claim 15.

Double Patenting

Examiner suggests that should Claims 1-11 be found allowable, Claims 16-20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Based on the amendment to Claims 1-11 from a method of making to a method of playing, Applicant submits that Claims 16-20 are not a substantial duplicate of Claims 1, 3-8, 10 and 11, and thus, respectfully requests Examiner to withdraw any objection to Claims 16-20 should Claims 1, 3-8, 10 and 11 be found allowable.

Claim Rejections – 35 U.S.C. § 102

Wooden

Examiner rejected Claims 1-4, 9-11, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,226,419 to Wooden. Examiner asserts that Wooden teaches a game comprising game units of plurality of game pieces (70, 80, 90, 100, 110, 111, 112), a playing surface with path and spaces (3, 4, 5, 6) sized to accommodate game units (Fig. 6-7), and further providing rules for restricting movement of pieces (4:67-5:45).

Claims 1-4, 9-11

Applicant has amended Claim 1 to a method of playing and has canceled Claims 2 and 9. Applicant respectfully submits that Claim 1, as amended, is not anticipated by Wooden. Wooden does not disclose, teach, or suggest moving game pieces of a selected game unit along the spaces of the playing surface, wherein at least one of the game pieces of a selected game unit, after being moved, remains within a predetermined number of spaces of another game piece of the selected game unit. Rather, Wooden describes restricting movement when the vector of one player's game piece is pointing towards a vector of an opponent's game piece. (Wooden at 5:18-33.) Accordingly, Applicant respectfully requests Examiner to withdraw this rejection with respect to Claims 1.

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Applicant also requests Examiner to withdraw this rejection with respect to Claims 3-4, 10, and 11. Claims 3-4, 10 and 11 are dependent on Claim 1 and thus, incorporate the limitations of amended Claim 1. Further, Wooden does not disclose, teach, or suggest the unique combination of features recited in Claims 3-4, 10 and 11. Therefore, Claims 3-4, 10 and 11 are patentable over Wooden.

Claims 16-17

With respect to Claim 16, Applicant has amended Claim 16 to recite, *inter alia*, a playing surface having a plurality of spaces for movement of the primary and secondary game pieces, wherein the plurality of spaces form a path, and the primary and secondary game pieces are *configured to move separately* from one another along the path. Applicant submits that Claim 16, as amended, is not anticipated by Wooden. Examiner asserts that Wooden teaches primary (70) and secondary (110, 111, 112) game pieces. The piece 70 is configured to receive pieces 110, 111, and 112, by way of an opening in piece 70. (Wooden at 3:58-61; *Id.* at 4:20-26.) The pieces 110, 111, and 112 are not configured to move along the playing surface or along a path on the playing surface separately from piece 70. Therefore, Wooden does not anticipate amended Claim 16. Accordingly, Applicant respectfully requests Examiner to withdrawn this rejection with respect to Claim 16.

With respect to Claim 17, Applicant submits that Claim 17 is also not anticipated by Wooden. Claim 17 is dependent on Claim 16 and thus, incorporates the limitations of amended Claim 16. Further, Wooden does not teach or suggest the unique combination of features recited in Claim 17. Accordingly, Applicant respectfully requests Examiner to withdrawn this rejection with respect to Claim 17.

Schick

Examiner rejected Claims 1-10 and 16-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,582,080 to Schick. Examiner asserts that Schick teaches a game comprising game units of plurality of game pieces (Fig. 5-6), a playing surface with a path and spaces sized to accommodate game units (Fig. 6-7) with a total of eight pieces which are capable of being placed on one space (pieces riding piggybacked), and further providing rules for restricting movement of pieces (4:7).

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Claims 1-10

Applicant has amended Claim 1 to a method of playing and has canceled Claims 2 and 9. Applicant respectfully submits that Claim 1, as amended, is not anticipated by Schick. Schick does not disclose, teach, or suggest providing a plurality of game units, wherein each game unit comprises a plurality of game pieces, wherein the plurality of game pieces are configured to move separately from each other along the at least one path. Rather, Schick describes a basic, primary playing piece and a plurality of secondary playing pieces, wherein the primary playing piece has a recess on one side for receiving one of the plurality of secondary playing pieces. (Schick at 1:16-24; *Id.* at 3:34-40.) The secondary playing pieces of Schick do not move separately from or independently from the primary playing piece. (Schick at 4:10-6:58.) Therefore, Schick does not anticipate Claim 1. Accordingly, Applicant respectfully requests Examiner to withdraw this rejection with respect to Claim 1.

Applicant also requests Examiner to withdraw this rejection with respect to Claims 3-8, 10, and 11. Claims 3-8, 10, and 11 are dependent on Claim 1 and thus, incorporate the limitations of amended Claim 1. Further, Schick does not teach or suggest the unique combination of features recited in Claims 3-8, 10 and 11. Therefore, Claims 3-8, 10 and 11 are patentable over Schick.

Claims 16-20

Applicant has amended Claim 16 to recite a game comprising, *inter alia*, a playing surface having a plurality of spaces for movement of the primary and secondary game pieces, wherein the plurality of spaces form a path, and the primary and secondary game pieces are configured to move separately from one another. As discussed above, Schick does not disclose a game, wherein the primary and secondary game pieces are configured to move separately from one another. Therefore, Schick does not anticipate amended Claim 16. Accordingly, Applicant respectfully requests Examiner to withdraw this rejection with respect to Claim 16.

Applicant also requests Examiner to withdraw this rejection with respect to Claims 17-20. Claims 17-20 are dependent on Claim 16 and thus, incorporate the limitations of amended Claim 16. Further Schick does not disclose, teach, or suggest the unique combination of features recited in Claims 17-20. Therefore, Claims 17-20 are patentable over Schick.

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Claim Rejections – 35 U.S.C. § 103

Examiner rejects Claims 12-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,346,899 to Nuebling in view of U.S. Patent No. 4,903,969 to Williams. Examiner asserts that Nuebling teaches a method of playing a board game comprising selecting a primary (35) and a secondary (39) piece, placing them as a unit on a space (9:3-5), rolling a die and moving primary and secondary pieces (9:5-7), and keeping primary and secondary pieces within a predetermined number of spaces (9:24-30). Examiner submits, however, that Nuebling does not teach a combined move by primary and secondary pieces equaling a total of the card number. Instead, Examiner relies on Williams. Examiner asserts that Williams teaches a board game allowing a player to move multiple pieces to a total roll and that making a combined move to a total roll would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant disagrees with Examiner's assessment that it would have been obvious to combine the teachings of Nuebling and Williams because, among other things, neither Nuebling nor Williams suggests a motivation to make such a combination.

Applicant, however, has amended Claim 12 to recite a method of playing a game comprising, *inter alia*, moving one or both of the at least one primary game piece and the at least one secondary game piece of the selected game unit a certain number of spaces along the playing surface corresponding to the number on the at least one playing card, wherein the combined number of spaces moved by both pieces equals the number on the at least one playing card, wherein the at least one secondary game piece and the primary game piece are configured to move separately along the path, wherein the at least one secondary game piece after being moved remains within a predetermined number of spaces of a corresponding primary game piece.

Applicant submits that neither Nuebling nor Williams discloses or suggests, individually or in combination, a game with a game unit with primary and secondary game pieces configured to move separately along the same path.

Nuebling describes a two-part playing piece consisting of a pedestal and a sports figurine which are held together by a magnetic bond for making player's moves on a principal course. (Nuebling at 2:35-38.) The pedestal and the figurine must be joined in order for a player to move the two-part playing piece on the principal course. (Nuebling at 2:42-45.) Although Nuebling also describes the possibility of moving the figurine without its matched pedestal in a secondary

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course, the matched pedestal is not permitted to move on the principal course while the figurine is in the secondary course nor is the matched pedestal able to even enter or move in the secondary course. (Nuebling at 2:38-42.) Therefore, Nuebling does not disclose or suggest at least two game pieces, a secondary game and a primary game piece, configured to move separately along a path as recited in Claim 12. Moreover, Nuebling does not disclose or suggest keeping the at least one secondary game piece, after being moved, within a predetermined number of spaces of a corresponding primary game piece.

As with Nuebling, Williams does not disclose or suggest at least two game pieces, a secondary and a primary game piece, configured to move separately along a path as recited in Claim 12, wherein at least one secondary game piece after being moved remains within a predetermined number of spaces of a corresponding primary game piece. First, Williams does not disclose a secondary and primary game piece. Williams describes four groups of marking player pieces, six marking pieces each, wherein each group corresponds to a group color associated with a removable game board device. (Williams at 4:37-47.) The six marking pieces in Williams are not taught or disclosed as being distinguishable from each other within a group nor are they taught or disclosed as being ordered or ranked such that one of the six marking pieces are dependent on another one of the six marking pieces. Second, Williams does not disclose keeping a particular game piece within a predetermined number of spaces with another game piece after being moved. As mentioned earlier, Williams does not distinguish one marking piece from another marking piece within a group. As such, Williams also does not disclose limiting the movement of any one of the marking pieces of a group based on the particular location of a given marking piece of that group.

Therefore, the method recited in Claim 12 would not have been obvious to one of ordinary skill in the art in view of Nuebling and Williams, and thus, Claim 12 is patentable over the cited references.

Applicant also requests Examiner to withdraw this rejection with respect to Claims 14 and 15. Claims 14 and 15 are dependent on Claim 12 and thus, incorporate the limitations of amended Claim 12. Further, neither Williams nor Nuebling teaches or suggests the unique combination of features recited in Claims 14 and 15. Therefore, Claims 14 and 15 are patentable Nuebling in view of Williams.

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New Claims

Applicant has added new Claims 21 and 22. Claim 21 recites a method of playing a game that includes the limitations of Claim 12, wherein placing the selected game unit on the playing surface involves placing at least one primary game piece and at least one secondary game piece of the selected game unit on the same space of the playing surface. Claim 22 recites a method of playing a game that includes the limitations of Claim 12, wherein placing the selected game unit on the playing surface involves placing the at least one primary game piece and the at least one secondary game piece of the selected game unit on different spaces of the playing surface. None of the cited references, alone or in combination, teach the features recited in Claim 21 or Claim 22. Accordingly, Claims 21 and 22 are in condition for allowance.

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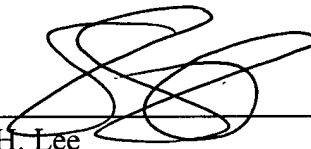
CONCLUSION

In view of the foregoing amendments and remarks, this application, as amended, is in condition for allowance and such action is respectfully requested. However, if any issues remain or require further clarification, Examiner is requested to call Applicant's counsel at the telephone number indicated below in order to resolve such issues promptly.

Respectfully submitted,

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